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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,910	11/08/2000	Edward J. Walters	26495.101.US02	9069

26853 7590 01/17/2003

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EXAMINER

ROBINSON, GRETA LEE

ART UNIT PAPER NUMBER

2177

DATE MAILED: 01/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/707,910

Applicant(s)

WALTERS ET AL.

Examiner

Greta L. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____    | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

1. Claims 1-49 are pending in the present application.

#### *Drawings*

2. The drawings are objected to by the Draftsperson note attached from PTO 948 for Draftsperson's Review. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claims 1 and 21**, the following limitation lacks proper antecedent basis: "said responsive records" [see claim 1 line 3; and claim 21 line 2].

Regarding **claims 1 and 21**, the following limitation is vague: "displaying selected elements of at least one of said responsive records, wherein said list of identifiers and said selected

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elements are displayed simultaneously” [see: claim 1 lines 5-7, claim 21 lines 4-6]. It is unclear as to what the selected elements include, are they the database 402, text 403, or sort process 404 depicted in figure 4.

Claims 2-20 and 22-49 are rejected based on dependency.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 1-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barr et al. US Patent 5,873,076 in view of Schmitt US Patent 6,463,431 B1.

Regarding claim 1, **Barr et al.** teaches a method for displaying records responsive to a database query [note: query server 116, figure 3] comprising the steps of:

displaying a list of identifiers for a plurality of said responsive records [note: element 204 figure 2];

and

displaying selected elements of at least one of said responsive records,  
wherein said list of identifiers and said selected elements are displayed  
simultaneously [note: element 206 figure 2; figures 4A and 5; col. 12 lines 48-57; col. 14 lines 29-65].

Although Barr et al. teaches the invention substantially as cited above, they do not specifically teach simultaneous display of said list of identifiers and selected elements. **Schmitt** teaches a user interface that enables the user to comparatively evaluate multiple items simultaneously by adjustment of the attribute weightings and the proximity searcher can also simultaneously display a nearest neighbor item and a users selected item [see: abstract; figure 3; col. 3 line 23 through col. 4 line 17]. It would have been obvious to one of ordinary skill at the time of the invention to have combined Schmitt with Barr et al. because Schmitt's ability

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simultaneously display a list of items and selected items would allow the user keep items that may have been overlooked.

7. Regarding claims 2-5:

(Claim 2) wherein said selected elements comprise the entirety of one of said responsive records [Barr et al., Figure 4A and 5].

(Claim 3) wherein said identifiers comprise case citations [Barr et al., figure 4A and 5].

(Claim 4) further comprising the step of identifying and marking records displayed in their entirety in a prior search request [Barr et al., 206 figure 2 and figure 4A].

(Claim 5) further comprising the step of identifying and marking records that were responsive to a prior search request [Barr et al., 206 figure 2 and figure 4A].

8. Regarding claims 6, 8, and 15 note Barr et al.:

(Claim 6) further comprising the step of sorting said responsive records [col. 13 lines 30-67].

(Claim 7) wherein said responsive records include a record name;  
a record citation; a record date; and a record author [note element 400 figure 5].

(Claim 15) further comprising the step of resolving ties in a preceding sort [col. 13 lines 30-67].

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9. Regarding claim 7 note Barr et al.:

further comprising the step of computing the relevance of said responsive records [col. 13 lines 30-67].

10. Regarding claims 9-14:

further comprising the step of computing the relevance of said records ... wherein said list of responsive records is sorted according to record name ... citation ... date ... record author ... relevance of records [Barr et al. Figure 5; also note Schmitt figure 3 and col. 3 lines 22-44].

11. Regarding claims 16-20:

further comprising the step of identifying responsive records that were displayed in their entirety in a prior search ... wherein said responsive records are identified with text ... are identified with icons ... color ... with a browser viewed link designation [Barr et al. figure 4a and 5; figure 3 Schmitt].

12. The limitations of apparatus claims 21-49 parallel method claims 1-20 therefore they are rejected under the same rationale.

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***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Driscoll** US Patent 5,642,502

**Husick et al.** US Patent 5,717,914

**Nakabayashi et al.** US Patent 5,826,263

**Redfern** US Patent 6,078,914

**Marshall et al.** US Patent 5,926,806

**Marshall et al.** US Patent 6,101,493

**Singhal** US Patent 6,370,527 B1

**Jones et al.** US Patent 6,415,307 B2

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta Robinson whose telephone number is (703)308-7565. The examiner can normally be reached Monday through Friday from 9:30 AM to 6:00 PM.

If any attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached at (703)305-9790.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231



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**or faxed to:**

(703)746-7239, (for formal communications; please mark "EXPEDITED  
PROCEDURE")

**Or:**

(703)746-5657, (for informal or draft communications, please label "PROPOSED" or  
"DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2021 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be  
directed to the Group receptionist whose telephone number is (703)305-9600.



**GRETA ROBINSON**  
**PRIMARY EXAMINER**

Greta Robinson

Primary Examiner

January 11, 2003